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KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

EXAMINER
LANEAU, RONALD

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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/798,342
Filing Date: March 12, 2004
Appellant(s): MERRIMAN ET AL.

Bradley J. Meier
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/19/06 appealing from the Office action

mailed 3/18/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A. Pending Appeals:

Reissue application no. 09/577,798 is currently awaiting BPAI docketing. It is based upon U.S. Pat. No. 5,948,061, for which a Rule 607 Notice of Attempt to Provoke Interference was mailed on March 10, 2003.

B. Prior Appeals:

Patent application no. 09/094,949 is allowed with a scheduled issued date of Mai 2, 2006 following a BPAI Decision On Appeal, mailed on February 7, 2005, reversing the Examiner's rejections.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,960,409   WEXLER   9-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-15 and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by

Wexler (US 5,960,409).

As per claims 1-5, 9, Wexler teaches a method for advertising, comprising: receiving an

advertisement request from a user node, wherein said advertisement request is based upon a link

sent from an affiliate node to said user node in response to a content request sent from said user

node to said affiliate node (col. 4, lines 54-57 and col. 5, lines 1-8); and selecting, in response to

said advertisement request, an advertisement based upon stored information about said user node

(col. 4, lines 61-67), the network consists of a plurality of nodes, wherein a user a first node (user

node) views a first quantity of information provided by a second node (publisher) for the benefit

of a fourth node (advertiser) (col. 6, lines 15-19).

As per claim 6, the system of Wexler inherently teaches a system wherein the stored

information includes at least one of the network address of said user node, the domain type of

said user node, the time zone of said user node, the geographical location of said user node, and

an industry code for statistical purposes or satisfaction index calculation as claimed.

As per claim 7, Wexler teaches a system wherein said stored information includes the

number of times an advertisement has been sent to said user node (col. 5, lines 26-29).

As per claim 8, Wexler teaches a system wherein selecting an advertisement is further

based upon at least one of a browser type, a browser version, an operating system type, and a

proxy server, each associated with said user node (col. 3, lines 29-31).

As per claims 9-14, Wexler teaches a system wherein if selection criteria associated with

more than one advertisement are satisfied based upon said stored information, then calculating a

satisfaction index for each advertisement, and selecting the advertisement with the lowest

satisfaction index, wherein said satisfaction index for an advertisement is directly proportional to

the number of times said advertisement is sent to a user node, wherein said satisfaction index for

an advertisement is inversely proportional to the amount of time expired since said advertisement

was first permitted to be sent to a user node, wherein said satisfaction index for an advertisement

is inversely proportional to the maximum number of times the advertisement is permitted to be

sent to a user node, wherein said satisfaction index for an advertisement is directly proportional

to the total amount of time over which said advertisement is permitted to be sent (tallying clicks

and generating statistics for multiple banner publishing site and multiple advertisers are

equivalent to the satisfaction index calculation as claimed) (col. 5, lines 32-44).

As per claim 15, Wexler inherently teaches an advertisement request that would include

an Internet Protocol address associated with a user node as claimed.

As per claim 19, Wexler teaches a system further comprising sending said selected

advertisement to said user node for display (col. 5, lines 29-31).

As per claims 20-22, Wexler teaches a system comprising receiving from said user node

a click through request for information about the advertiser associated with said selected

advertisement, further comprising sending a network address for said advertiser to said user node

in response to said click-though request, wherein said stored information includes information

about a prior click-through request received from said user node (col. 3, line 65 to col. 4, lines 9,

see abstract).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US

5,960,409).

As per claims 16-18, Wexler does not teach a system performing a reverse domain lookup table based upon an internet protocol address, selecting an advertisement based upon the results of said reverse domain and perform a trace operation route but it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a lookup table as claimed because it would increase flexibility of the system since arbitrary functions can be realized with lookup tables, the Official notice is taken as such.

(10) Response to Argument

Applicant argues that Wexler does not disclose or suggest "selecting, in response to said advertisement request, an advertisement based upon stored information about said user node." Contrary to Applicant's arguments, Wexler discloses a banner wherein a user can click to access an advertiser web site through a third party. By clicking on the banner, the user sends a request signal to a third party wed site which then redirect the request the advertiser web site which downloads the information originally sought by the user to his web browser. The user at the end does select an advertisement based upon stored information as claimed. In response to Applicant's arguments about the suggestion or motivations by the Office action, it is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements that applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. In re Sheckler, 168 USPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968). Applicant's arguments are deemed unpersuasive, claims 1-22 remain rejected.

For the above reasons, it is believed that the rejections should be sustained.
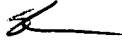
Respectfully submitted,

Ronald Laneau

Primary Examiner

Conferees:

Alexander Kalinowski, SPE

Hyung Sough, SPE